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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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33M1/0409

EXAMINER

JACKSON, G

ART UNIT

PAPER NUMBER

3309

DATE MAILED: 04/09/97

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT PAPER NUMBER

3

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined.  Responsive to communication filed on \_\_\_\_\_  This action is made final.  
A shortened statutory period for response to this action is set to expire THREE (3) month(s), -- days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.  \_\_\_\_\_

**Part II SUMMARY OF ACTION**

1.  Claim(s) 1-72 are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is withdrawn from consideration.
2.  Claim(s) \_\_\_\_\_ has been canceled.
3.  Claim(s) 40-43,54-60 and 65-72 are allowed.
4.  Claim(s) 1-6, 10-19, 21,24-27, 29-31, 33, 35, 39, 44, 47 and 61-63 are rejected.
5.  Claim(s) 7-9, 20, 22-23, 28, 32, 34, 36-38, 45-46, 48-53 and 64 are objected to.
6.  Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.
7.  This application has been filed with informal drawing(s) under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8.  Formal drawing(s) are required in response to this Office action.
9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).
11.  The proposed drawing correction(s), filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).
12.  Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14.  Other

  
GARY JACKSON  
PRIMARY EXAMINER  
GROUP 3300

***Claim Rejections - 35 USC § 112***

1. Claims 1 and 39 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 lacks a clear description of the intended use of the method steps in the preamble. The examiner suggests inserting --A method of positioning a suture anchor in body tissue-- at the beginning of line 1. Claim 39 elements lacks clear cooperative structural relationship to the other elements.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 1-6, 10-19, 21, 24-27, 29-31, 33, 35, 44 and 47 are rejected under 35 U.S.C. § 103 as being unpatentable over DiPoto et al (5,258,016) in view of Hayhurst et al (5,041,129). DiPoto discloses the method steps as recited in claims above except the hole in the tissue is predrilled. The secondary reference teaches that tissue can be pierced with an insertion member. It would have been within the preview of one having ordinary skill in the art to insert DiPoto's member into tissue without predrilling the hole into the tissue.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 61-63 are rejected under 35 U.S.C. § 102(b) as being anticipated by Warren (5,400,805). Element 400 is considered a driver piercing member.

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***Allowable Subject Matter***

6. Claims 7-9, 20, 22-23, 28, 32, 34, 36-38, 45-46, 48-53 and 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claims 40-43, 54-60 and 65-72 are allowable over the prior art of record.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (703) 308-4302.



GARY JACKSON  
PRIMARY EXAMINER  
GROUP 3300

Gary Jackson/gj  
March 29, 1997  
Fax (703) 308-0758